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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,252	04/22/2004	David Kieseckamp	ALC 3131	7271

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EXAMINER

COLAN, GIOVANNA B

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,252

Applicant(s)

KIESEKAMP ET AL.

Examiner

Giovanna Colan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to applicant filed application on 04/22/2004.
2. Claims 1 – 16 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9 – 16 are rejected under 35 U.S.C. 101 because:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

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Claim 9 merely claims nonfunctional descriptive material, i.e., abstract ideas, such as "instructions for" stored on a computer-readable medium, which does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.>").

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Khan (US Patent No. US 6,546,393 B1, issued: April 8, 2003).

Regarding Claims 1, and 9, Khan discloses a computer-readable medium having instructions for providing access to views of network objects within an application for viewing or managing a communication network having a hierarchy of network objects, the application providing a graphical user interface through which an operator can issue instructions, the computer-readable medium comprising:

instructions for storing a stored bookmark list of bookmarks (Col. 19, lines 25 – 34, Khan), each bookmark being associated with a network object (Col. 21, lines 40 – 44, Khan);

instructions for displaying the bookmark list in the graphical user interface (Fig. 5, items 304, 314, 316, and 318, Col. 13, lines 30 – 35, Khan);

instructions for displaying information concerning the network object associated with a bookmark selected by the operator, in the event that the operator selects a bookmark in the stored bookmark list (Col. 17, lines 51 – 60, Khan); and

instructions for adding a new bookmark to the stored bookmark list, the new bookmark being associated with a currently displayed network object, in the event that the operator issues instructions to add a new bookmark to the stored bookmark list (Fig. 9, item 902, Col. 15, lines 61 – 67, Khan).

Regarding Claims 2, and 10, Khan discloses a computer-readable medium wherein the instructions for storing the stored bookmark list comprise instructions for storing the stored bookmark list uniquely in association with the operator (Col. 12, and 19, lines 6 – 12, and 25 – 34; respectively, Khan).

Regarding Claims 3, and 11, Khan discloses a computer-readable medium wherein the instructions for displaying the bookmark list comprise instructions for displaying the bookmark list as part of a drop down menu, the drop down menu further

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including a menu command by which the operator can issue instructions to add a new bookmark to the stored bookmark list (Fig. 9, item 902, Col. 15, lines 61 – 67, Khan).

Regarding Claims 4, and 12, Khan discloses a computer-readable medium further comprising:

instructions for displaying a bookmark management window including a temporary bookmark list initially identical to the stored bookmark list, in the event that the operator issues instructions to manage the bookmarks (Fig. 7, Col. 15, lines 34 – 38, Khan);

instructions for creating a bookmark group, in the event that the operator issues instructions to create a bookmark group (Col. 11, lines 15 – 20, and 25 – 2, Khan);

instructions for assigning one of the bookmarks in the temporary bookmark list to one of the bookmark groups, in the event that the operator issues instructions to assign one of the bookmarks in the temporary bookmark list (Col. 13, lines 7 – 8, and 18 – 20; wherein the step of creating a new node in the category tree corresponds to the step of assigning one of the bookmarks in the temporary bookmark list claimed; Khan); and

instructions for storing the temporary bookmark list as the stored bookmark list, in the event that the operator issues instructions to save the bookmark list (Col. 13, lines 21 – 23; the addition is then finalized and included in the site directory; Khan).

Regarding Claims 5, and 13, Khan discloses a computer-readable medium wherein the instructions for displaying the bookmark list comprise instructions for

displaying the bookmark list as part of a drop down menu, the drop down menu further including a command by which the operator can issue instructions to manage the bookmarks (Fig. 7, and 9, item 902, Col. 15, lines 34 – 38, and 61 – 67, Khan).

Regarding Claims 6, and 14, Khan discloses a computer-readable medium wherein the instructions for providing a bookmark management window comprise instructions for displaying a New Folder button, a Rename button, a Delete button, an OK button, and a Cancel button, and the computer-readable medium further comprising:

instructions for allowing the operator to designate any bookmark in the temporary bookmark list as a selected bookmark (Col. 13, lines 7 – 8, and 18 – 20; wherein the step of creating a new node in the category tree corresponds to the step of assigning one of the bookmarks in the temporary bookmark list claimed; Khan);

instructions for prompting the operator to enter a new bookmark group name and creating a new bookmark group having the new bookmark group name in the temporary bookmark list, in the event that the operator selects the New Folder button (Fig. 12, items 1200, 1206, 1208, and 702, Col. 11, and 16, lines 15 – 20 and 25 – 2, and 47 – 50; respectively, Khan)

instructions for prompting the operator to enter a new bookmark name (Fig. 9, item 902, Col. 15, lines 61 – 67, Khan) and renaming the selected bookmark with the new bookmark name, in the event that the operator selects the Rename button (Col. 15, lines 35 – 38, Khan);

instructions for deleting the selected bookmark from the temporary bookmark list, in the event that the operator selects the Delete button (Col. 21, lines 30 – 33, Khan); and

instructions for closing the bookmark management window, in the event that the operator selects the Cancel button (Col. 22, lines 46 - 50, Khan); and

wherein the instructions for storing the temporary bookmark list as the stored bookmark list are executed in the event that the operator selects the OK button (Fig. 7, item 702, Col. 15, lines 35 – 40, Khan).

Regarding Claims 7, and 15, Khan discloses a computer-readable medium wherein the instructions for providing a bookmark management window further comprise instructions for displaying a Clean Up button, and the computer-readable medium further comprising:

instructions for removing from the temporary bookmark list any bookmarks for which the associated network object no longer exists within the hierarchy of network objects, in the event that the operator selects the Clean Up button (Fig. 23, item 2300, Col. 21, lines 18 – 21, Khan).

Regarding Claims 8, and 16, Khan discloses a computer-readable medium wherein the instructions for storing the stored bookmark list comprise instructions for storing the stored bookmark list uniquely in association with the operator (Col. 12, and 19, lines 6 – 12, and 25 – 34; respectively, Khan).

Prior Art Made Of Record

1. Khan (US Patent No. US 6,546,393 B1, issued: April 8, 2003).
2. Himmel et al. (US Patent No. 6,480,852 B1).


Points Of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna Colan whose telephone number is (571) 272-2752. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Giovanna Colan
Examiner
Art Unit 2162
October 2, 2006


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